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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,198	10/31/2001	Jeffrey Erdfarb	12186/1	4144
26646	7590	10/22/2003	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			COHEN, AMY R	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,198

Applicant(s)

ERDFARB, JEFFREY

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hellar (U. S. Patent No. 5,251,382).

Hellar teaches a measuring device (1) comprising: a first edge (2) defining a first region, said first region having a first set of indicia (8) corresponding to a first linear scale, wherein said first linear scale is actual (Col 2, lines 61-65); a second edge (3) defining a second region, said second region having a second set of indicia (9) corresponding to a second linear scale, wherein said second linear scale is non-actual (Col 2, lines 65-67), such that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale (Col 2, lines 61-67, the second linear scale is half-scale).

Hellar teaches the device wherein said second linear scale is selected from the group of $\frac{3}{4}"=1'$, $\frac{1}{2}"=1'$, $\frac{3}{8}"=1'$, $\frac{1}{4}"=1'$, $\frac{1}{8}"=1'$, $\frac{1}{16}"=1'$, 1:2, 1:4, 1:8, 1:10, and 1:100 (Col 2, line 61- Col 3, line 4, the second linear scale is half-scale).

Hellar teaches the device wherein each indicia of said first and second sets of indicia comprise a hash mark and a numeral (Fig. 2).

Hellar teaches the device wherein each of said first and second set of indicia have a starting point adjacent to each other (33 and Fig. 2).

Hellar teaches the device wherein at least one of said first and said second linear scales is in S. I. units (Col 2, lines 61-65, the metric scale may be chosen).

Hellar teaches the device wherein at least one of said first and said second linear scales is in U. S. units (Col 2, lines 61-65).

Hellar teaches the device comprising a third region disposed between said first region and said second region (Fig. 2), said third region having a third set of indicia corresponding to a third linear scale (scale in feet-as seen in Figs. 1 and 2 and reference number 21).

Hellar teaches the device wherein said third set of indicia extend through one of said first region to said first edge and said second region to said second edge (21 in Fig. 2).

3. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wall (U. S. Patent No. 5,230,158).

Wall teaches a measuring device (10) comprising: a first edge (11) defining a first region, said first region having a first set of indicia (20) corresponding to a first linear scale, wherein said first linear scale is actual (Col 4, lines 41-54); a second edge (12) defining a second region, said second region having a second set of indicia (30) corresponding to a second linear scale, wherein said second linear scale is non-actual, such that a non-actual dimension determined by the second edge in the second linear scale corresponds directly to an actual dimension determined by the first edge in the first linear scale (Col 4, lines 17-40 and 55-68).

Wall teaches the measuring device wherein said first region (11) is divided into at least a first portion and a second portion (Figs. 2, 3, 5, 6), wherein said first portion includes said first

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set of indicia and said second portion includes a third set of indicia corresponding to a third linear scale (in Figs. 2, 3, 5, and 6 the arrow indicates a new set of numbers).

Wall teaches the measuring device wherein said second region (12) is divided into at least a first portion and a second portion (Fig. 2-5), wherein said first portion includes said first set of indicia and said second portion includes a third set of indicia corresponding to a third linear scale (in Figs. 2-5 the arrow indicates a new set of numbers).

4. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Engel (U. S. Patent No. 1,497,492).

Engel teaches a method for measuring, comprising the steps of: positioning a measuring device on a drawing (Col 1, lines 24-43), said measuring device (10) having a first set of indicia (Fig. 1 "inches") corresponding to a first linear scale and a second set of indicia (Fig. 1, all other scales shown, except the scale "MM" which is also an actual scale) corresponding to a second linear scale, wherein said drawing has features sized in a second linear scale (Col 1, lines 24-43); using said second set of indicia, determining a first length of measurement of a feature on said drawing (Col 1, lines 24-43); using said first set of indicia, determining a second length measurement on an object, wherein said first length measurement and said second length measurement correspond to the same actual dimension (Col 1, lines 24-52, Fig. 1).

Response to Arguments

5. Applicant's arguments filed 11 June 2003 have been fully considered but they are not persuasive.

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6. In response to applicant's argument that U. S. Patent No. 5,251,382 "Hellar" does not teach using the device for a "feature on a drawing" (Remarks paragraph II.), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Examiner maintains that Hellar teaches a measuring device having a first actual scale (8) and a second non-actual scale (9). The second non-actual scale is half-scale to the first actual scale. Regardless of intended use, in that Applicant argues that the intended use of the measuring device is to locate a centerpoint of a measurement, the structure of Hellar's measuring device is capable of performing the Applicant's intended use of "determining the dimensions of a feature on a drawing."

7. In response to applicant's argument that U. S. Patent No. 5,230,158 "Wall" does not teach using the device for a "feature on a drawing" (Remarks paragraph III.), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Again, the structure of the measuring device of Wall is capable of performing the Applicant's intended use of "determining the dimensions of a feature on a drawing."

Structurally, Wall does teach a first actual scale (20) and a second non-actual scale (30).

8. Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection.

9. Examiner notes, claim 2 was cancelled in the Amendment filed 10 February 2003, therefore arguments concerning claim 2 have not been considered since it is no longer present.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC
October 17, 2003



Diego Gutierrez
Supervisory Examiner
Tech Center 2800